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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,156	02/13/2002	Heather N. Bean	10015233-1	6927

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/075,156	BEAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Betelhem - Shewareged	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 25 September 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) 6,7 and 15-20 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-4 and 8-14 is/are rejected.  
7)  Claim(s) 5 is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ . 6)  Other: \_\_\_\_ .

**DETAILED ACTION**

1. Applicant's response filed on 09/25/2003 has been fully considered. The claim objections and the prior art rejections to claims 1-4, 8 and 11-14 under 35 U.S.C. 102(b) as being anticipated by Magill et al. (US 5,813,772), claims 1-4, 8-10 and 12-14 under 35 U.S.C. 102(b) as being anticipated by Onishi et al. (US 5,955,167), and claims 1, 2 and 8-13 under 35 U.S.C. 102(b) as being anticipated by Haruta et al. (US 5,922,625) have been withdrawn in view of Applicant's amendments and comments.
2. Claims 1, 11 and 13 are amended, and claims 1-20 are pending. (NOTE: Claims 6, 7 and 15-20 are still withdrawn from consideration as non-elected claims).

***Election/Restrictions***

3. Applicant's election of Group I, Species A in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Claim Rejections - 35 USC § 102***

4. Claims 1-3 and 8-14 rejected under 35 U.S.C. 102(e) as being anticipated by Mahn, Jr. (US 6,224,958 B1).

Mahn discloses a label comprising a printable rubber layer 12, and strips of pressure sensitive adhesive 18 on one side of the rubber layer, and a release sheet 20

Art Unit: 1774

on the pressure sensitive adhesive, wherein a coating layer 14 is applied on the other surface of the rubber layer and indicia is printed on the coating layer (col. 2, lines 23-36). The pressure sensitive adhesive remains with the rubber layer (col. 2, line 33). The rubber layer is equivalent to the claimed first sheet and rubber sheet, the coating layer is equivalent to the claimed print coating applied on the first sheet, and the release sheet is equivalent to the claimed second sheet and carrier layer. The release sheet (or outer removable layer) is polyester (claims 7 and 8). With regard to claim 11, polyester is either a transparent or a translucent material.

### ***Response to Arguments***

5. Applicant's arguments have been fully considered but they are not persuasive. The arguments are based on that 1) prior art's invention is directed to a label or a transfer adapted to mark a rubber article that is utilized in the automotive industry; 2) indicia are applied to the label or transfer using a thermal transfer apparatus; and 3) the label or transfer is pre-printed and therefore teaches away from print media. The first argument is not persuasive because even though the label or transfer of the prior art is used to mark a rubber article, the label or the transfer itself comprises a printable rubber layer 12 (equivalent to the claimed first sheet of claim 1 and/or rubber sheet of claim 13), a release sheet 20 (equivalent to the claimed second sheet of claim 1 and/or carrier layer of claim 13), and strips of pressure sensitive adhesive between the printable rubber layer 12 and release sheet 20. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed

does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The second argument is not persuasive because the claimed invention is not directed to method of using the printable media. The claimed invention is directed to a printable media, and the process by which the image is formed on the printable media is not dispositive of the issue the patentability of the instant article claims.

The third argument is not persuasive because the indicia are printed on the label or transfer of the prior art after the label or transfer is formed (see col. 3, lines 37-45).

### ***New Rejection***

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mahn, Jr. (US 6,224,958 B1), as applied to 1-3 and 8-14, above and in further view of Magill et al. (US 5,813,772) and Onishi et al. (US 5,955,167).

Mahn does not teach that its release sheet 20 comprises a release agent. However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply a release agent on the surface of the release sheet 20 in order to enhance the releasing properties of the release sheet 20. Applying a release

Art Unit: 1774

agent on a layer or sheet to be peeled off is taught on col. 8, line 65 of Magill, and on col. 7, lines 46-51 of Onishi.

***Allowable Subject Matter***

8. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art neither teaches nor even fairly suggests that the strips of pressure sensitive adhesive remain with the release sheet.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

  
Betelhem Shewareged  
December 12, 2003.